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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

Applicant(s): Glen H. ERIKSON et al.

Serial No: 09/885,731 Group Art Unit: 1637

Filed: June 20, 2001 Examiner: S. Chunduru

Att. Docket No.: E1047/20056 Confirmation No.: 6800

For: NUCLEIC ACID MULTIPLEX FORMATION

REQUEST FOR RECONSIDERATION

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated December 2, 2003, favorable reconsideration is respectfully requested in view of the following remarks. Claims 1-5 and 7-55 are pending, with claims 28 and 30-55 being withdrawn from consideration pursuant to a restriction requirement.

Claims 1-5, 7-27 and 29 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,451,502 (hereinafter "George") in view of McGavin et al., J. Mol. Graphics, Vol. 7, pp. 218-232, 1989 (hereinafter "McGavin"). This rejection is respectfully traversed.

George teaches a method for creating double-stranded nucleic acid multiplex structures. McGavin is cited to remedy George's acknowledged failure to "specifically [teach] that the multiplex structure (probe-target complex) is [bonded] solely through Watson-Crick base triplets." See Office Action at page 4, last paragraph. McGavin discloses theoretical, computer-based models for multiplex nucleic acid sequences based on Watson-Crick bonding, but does not disclose or suggest

how the virtual structures described by the computer models could be prepared using real nucleic acids. Thus, McGavin is non-enabling prior art, which the Office Action applies based on an improper "obvious-to-try" standard of obviousness. In *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 726, 16 USPQ2d 1923, 1929 (Fed. Cir. 1990), the court held:

> [A]n "obvious-to-try" situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). However, we have consistently held that "obvious to try" is not to be equated with obviousness under 35 U.S.C. §103.

One skilled in the art at the time of the invention would have lacked motivation to employ the purely theoretical teachings of McGavin to modify the primary reference, George, and reach the claimed invention with a reasonable expectation of success. McGavin's virtual teachings provide no guidance regarding how George could be modified to reach the reality of the claimed invention. McGavin simply "does not contain a sufficient teaching of how to obtain the desired result." *Gillette Co., supra*, 919 F.2d at 726.

Accordingly, reconsideration and withdrawal of the obviousness rejection over George in view of McGavin are respectfully requested.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

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Request for Reconsideration Dated January 30, 2004
Reply to Office Action of December 2, 2003

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

January 30, 2004

By_____

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Please charge or credit our Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.